



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,816	09/22/2003	John Phenix	14846-21	2173

7590 03/08/2007
Michael B. Johannesen, Esq.
Lowenstein Sandler, P.C.
65 Livingston Avenue
Roseland, NJ 07068

EXAMINER

RADTKE, MARK A

ART UNIT	PAPER NUMBER
----------	--------------

2165

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/08/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/667,816

Applicant(s)

PHENIX, JOHN

Examiner

Mark A. X Radtke

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Remarks

1. In response to communications filed on 8 December 2006, claim(s) 2, 6 and 10 is/are cancelled and claim(s) 1, 3-5 and 7-9 is/are amended per Applicant's request. Therefore, claims 1, 3-5 and 7-9 are presently pending in the application, of which, claim(s) 1 is/are presented in independent form.
2. In light of Applicant's amendments, the objections to the specification have been withdrawn. Furthermore, the rejections under 35 U.S.C. 112 and 101 have been withdrawn. Applicant's amendments have necessitated new grounds of rejection.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claims 1, 3-5 and 7-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed to a method for comparing objects. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result. Specifically, the claimed subject matter does not produce a concrete result because the

Art Unit: 2165

claimed subject matter fails to be limited to the production of an assured, repeatable result. More specifically, the claimed subject matter does not produce an assured, repeatable result because certain inputs will not produce any output. Specifically, if step (a) determines that "said objects" are equal, the method will terminate without a result. Similarly, if the objects are not equal according to step (a), but there are no differences between the methods in step (e), the method will again terminate without a result.

Dependent claims are rejected because they depend from the rejected independent claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

1, 3-5 and 7-9 TM 3/1/01
6. Claims ~~4-5~~ and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason (U.S. Pat. No. 6,826,716) in view of Shirazi ("Java Performance Tuning", Section 7.5, "Recursion and Stacks", published September 2000, available online at: <http://proquest.safaribooksonline.com/0596000154>) and further in view of Keller et al. (U.S. Pat. No. 6,662,312).

As to claim 1, Mason teaches a computer implemented method for comparing a first object and a second object in an object-oriented operating system (see Abstract) comprising the steps of:

(a) determining whether the first object (see figure 4, element 412) is equal to the second object (see figure 4, element 406) (See column 12, lines 20-23. Deployment descriptors can be compared directly. XML tags are nodes in a tree, thus objects.) and if said objects are not equal (see column 2, lines 45-65);

(b) obtaining one or more methods from said first object and said second object (see column 12, lines 40-46);

(c) determining whether the one or more methods from said first object are equal to the one or more methods from said second object (see column 12, line 45, "reporting (444)"); and

(d) performing steps (b) and (c) until all of the methods for the first object and the second object have been obtained (see column 8, line 47, "For Each method-permission element")

(e) generating a document comprising a listing of differences between the methods (See column 12, line 45, "reporting (444)" and see column 15, lines 18-20); and

(g) displaying the human-readable form to a user (all computers have displays).

Mason does not explicitly teach recursively performing steps.

Shirazi teaches recursively performing steps (see pages 1-2).

Therefore, it would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have modified Mason by the teaching of Shirazi because "you can convert a recursive method into an iterative method" (see Shirazi, Section 7.5, lines 3-4).

Mason, as modified, still does not explicitly teach (f) transforming the document into human-readable form.

Keller et al. teaches (f) transforming the document into human-readable form (see figure 4).

It would have been obvious to one of ordinary skill in the relevant art at the time the invention was made to have modified Mason by the teaching of Keller et al. because Mason "can potentially generate many different kinds of test" (see Mason, column 15, lines 32-33) and the final step of Mason is "reporting" (see Mason, figure 4, element 444).

As to claim 3, Mason, as modified, teaches wherein step (b) further comprises storing names of said methods (see column 13, lines 64-65, "VAR METHODNAME"), step (c) comprises storing indicia representing the determination whether the methods are the same (see column 14, line 7, "For each match found") and step (e) comprises generating a document from said stored names and indicia (see column 15, line 21, "e1.printStackTrace()").

As to claim 4, Mason, as modified, teaches wherein said object-oriented operating system comprises JAVA (see Abstract) and step (a) comprises running an equality method on said objects (See Examiner's comments regarding claim 1. Testing whether objects are equal implies running an equality method).

As to claim 5, Mason, as modified, teaches wherein said object-oriented operating system comprises JAVA (see Abstract) and step (c) comprises running an equality method on said objects (See Examiner's comments regarding claim 1. Testing whether methods are equal implies running an equality method).

As to claim 7, Mason, as modified, teaches human-readable form (see Examiner's comments regarding claim 1).

Mason, as modified, does not expressly teach comprising XML.

However, these differences are only found in the nonfunctional descriptive material and are not functionally involved in the steps recited. The determination of human-readable would be performed the same regardless of file format. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, (see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)).

Therefore, it would have been obvious to a person of ordinary skill in the relevant art at the time the invention was made to display information to a human operator based on any type of file format, because such data does not functionally

relate to the steps in the method claimed and because the subjective interpretation of data does not patentably distinguish the claimed invention.

As to claim 8, Mason, as modified, teaches wherein transforming the document into human-readable form comprises transforming the document into a web page (see column 6, lines 62-67 and see column 10, lines 12-14).

As to claim 9, Mason, as modified, teaches wherein said object-oriented operating system comprises JAVA (see Abstract) and step (b) comprises invoking a get...() method of each object (JavaBeans consist of publicly-exposed set and get methods).

Response to Arguments

7. Applicant's arguments filed on 8 December 2006 with respect to the rejected claims in view of the cited references have been fully considered but are moot in view of the new grounds for rejection.

In response to Applicant's arguments that Mason does not teach "comparing a first object and a second object in an object-oriented operating system", the arguments have been fully considered but are not deemed persuasive. The quoted portion of the claims occurs in the preamble and is considered intended use. Thus, that portion of the

claim will not be granted patentable weight. However, Mason does in fact teach comparing two objects. At lines 40-46 in column 12 of Mason, a step of "creating [...] and instance of the JavaBean" is taught. Mason creates a local instance of the JavaBean being tested. The methods of that test JavaBean are verified (see Mason, column 12, lines 44-46, "invoking" and "reporting") against the description of the JavaBean being tested. So, Mason teaches comparing two objects because Mason creates a local copy of an object and compares its behavior (see Mason, column 12, lines 45-46, "reporting [...] whether invoking the [...] method succeeded") to the remote version of the object.

In response to Applicant's argument that Mason does not teach "generating a document listing of differences between the methods", the arguments have been fully considered but are not deemed persuasive. This difference list is generated at lines 18-20 of column 15 in Mason. Each time a method invocation fails, an Exception will be thrown. The "catch" block then outputs a message to the user saying "Unexpected exception during EJB method invocation:" and a stack trace. The stack trace can be interpreted by one of ordinary skill in the art to determine where errors occurred. In the case of the invention of Mason, errors will be displayed for each mismatched method. See "Display the Stack Trace".

Additional References

Art Unit: 2165

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following non-patent literature is cited to further show the state of art with respect to object equality testing in general:

"Difference-Based Modules: A Class-Independent Module Mechanism" by Ichisugi

"Interface Comparable" by Sun Microsystems

"Display the Stack Trace" from DevX

"Testing Interface Compliance with Abstract Test" by George

"JUnit Test Infected: Programmers Love Writing Tests" by Junit

"Spying on Components: A Runtime Verification Technique" by Barnett

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 2165

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications should be directed to the examiner, Mark A. Radtke. The examiner's telephone number is (571) 272-7163, and the examiner can normally be reached between 9 AM and 5 PM, Monday through Friday.

If attempts to contact the examiner are unsuccessful, the examiner's supervisor, Jeffrey Gaffin, can be reached at (571) 272-4146.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to Customer Service at (800) 786-9199.

maxr

3 March 2007


HOSAIN ALAM
SUPERVISORY PATENT EXAMINER